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In re Application of :
John W. Liskowitz & Dennis Just :
Application No. 09/234,810 :
Filed: January 21, 1999 :
Attorney Docket No. 715-1-060-CI :

ON PETITION

This is in response to the communication filed October 18, 1999, which is being treated as a petition under 37 CFR 1.47(a)."

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on January 21, 1999 without an executed oath or declaration and naming John W. Liskowitz and Dennis Just as joint inventors and without the filing fee.

Accordingly, on February 10, 1999, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing. On April 15, 1999, a new Notice to File Missing Parts was mailed in view of a memorandum in the file which states that the applicant has requested a new Notice in view of the fact that, while there was no authorization, the Office nevertheless charged the filing fees to applicant's deposit account. The new Notice

of April 15, 1999 required the submission of the filing fees, an executed oath or declaration and a surcharge for their late filing.

In response, on July 16, applicant submitted a combined Declaration and Power of Attorney (signed by only one inventor), the filing fees, a small entity statement, and a \$55 fee for an extension of time.

On October 6, 1999, the Office mailed a Notice of Incomplete Response stating that the oath or declaration is not executed in compliance with 37 CFR 1.64(a) because the signature of inventor Dennis Just was missing.

In response, on October 18, 1999, petitioner submitted the instant petition and a copy of a petition under 37 CFR 1.47(a) (with attachments) filed in prior Application No. 08/768,167. No fee for an extension of time accompanied the response, which is necessary in order to render the filing of the petition timely. However, in the communication filed July 16, 1999, petitioner authorizes the charging of any fees related to the filing and processing of the present application in accordance with 37 CFR 1.16 and 1.17. Therefore, a fee of \$625 (\$680 - \$55 = \$625) for a four month extension of time will be assessed to petitioner's Deposit Account No. 11-1153.

The petition states that inventor Just was named as a co-applicant in parent Application No. 08/768,167, of which the instant application is a continuation-in-part. The parent application contained a petition under 37 CFR 1.47(a) stating that inventor Just was contacted and requested to execute a Declaration and Power of Attorney but that inventor Just did not respond. Instead, correspondence was received from inventor Just's employer indicating that Dr. Just would not be permitted to execute the Declaration. A copy of the letter from inventor Just's employer accompanies the petition filed in the parent application as proof of the refusal to join in the application. The petition under 37 CFR 1.47(a) filed in the parent application further indicates that inventor Just was supplied with a copy of the application papers. Additionally, petitioner states that the circumstances regarding Dr. Just and the company Union Process remain the same, and efforts to contact Dr. Just have met with failure.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), petitioner has not demonstrated that a copy of the instant CIP application papers was presented to inventor Just for signature. Further, reliance upon the showing in the Rule 47 petition filed in the parent application (No. 08/768,167) is not justified since there is no indication from the computer database records that a petition under 37 CFR 1.47(a) was ever granted in that application. Nevertheless, since the instant application is designated as a continuation-in-part application and would by its definition contain new matter, and since inventor Just has never been presented with a copy of the CIP application papers, petitioner should make an effort to obtain the signature of inventor Just. While the inventor expressly refused through his employer to join in the parent application, the record fails to establish that inventor Just continues to refuse to join in the filing of the instant CIP application. In this regard, petitioner states that the "circumstances regarding Dr. Just and the company Union Process remain the same, and efforts to contact Dr. Just have met with failure." Petitioner has not presented any evidence of the diligent and continued efforts to contact inventor Just to obtain his signature on the application papers. Petitioner should show that a copy of the instant CIP application papers was presented to inventor Just, but that he did not respond to the request that he sign the oath/declaration in order to show that the inventor has refused to join in the instant CIP application. A copy of the CIP application papers (specification, claims and drawings) should be sent to the last known address of the non-signing inventor with a request that he sign the declaration for the patent application. Any renewed petition must be accompanied by documentary evidence of the attempts to locate and obtain the signature of inventor Just.

As to item (4) above, the petition does not set forth the last known address of non-signing inventor Just.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to Frances Hicks at 703) 305-8680.



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